

PATENT APP. NO. 10/058,065
ATTY. DOCKET NO. 53394.000559
RESPONSE TO MAY 18, 2005 OFFICE ACTION

IV. REMARKS/ARGUMENTS

A. Status of the Claims

Claims 1, 3-15, 17-22, 24-26, 28 and 29 are pending in the application. Claims 5 and 17 have been cancelled, without prejudice. The specification is objected to by the Examiner. Claims 1, 3-15, 17-22, 24-26, 28 and 29 stand rejected by the Examiner. Applicants respectfully request reconsideration of the rejections of claims 1, 3-15, 17-22, 24-26, 28 and 29 in view of the following remarks.

B. Objection to the Specification

The specification is objected to under 37 C.F.R. § 1.71 for allegedly failing to adequately teach how to make and/or use the invention. Specifically, the Office Action asserts that "[t]he disclosure gives a wide range of polymers as being suitable for providing the claimed performance characteristics. Additionally, specific test results are cited. No specific polymers or method of making the polymers are given. Without this disclosure, one of ordinary skill cannot practice the invention without undue experimentation." Office Action, Page 4. Applicants respectfully disagree.

Applicants submit that none of the polymers identified in the present application are novel. Instead, these polymers are well-known to one of ordinary skill in the art. Accordingly, Applicants are not required to disclose the method of making the polymers. *See In re Buchner*, 929 F.2d 660, 661 (Fed. Cir. 1991) ("A patent need not teach, and preferably omits, what is well known in the art.").

In addition, Applicants disagree with the Office Action's assertion that "[n]o specific polymers ... are given." For example, referring to the present specification, Applicants have described a particular subset of material combinations produces an absorbent core having the claimed front pad absorbent capacity of at least 32 grams:

A number of techniques may be used to provide an optimized front pad 40 to improve leakage protection. For example, high AUL SAP may be disposed in the front pad 40 of the absorbent core 6 to provide the desired front pad total absorptive capacity of at least about 32 grams.

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Alternatively, high concentrations of lower AUL SAP may be disposed in the front pad 40 of absorbent core 6 to provide the desired front pad total absorptive capacity of at least about 32 grams. In one embodiment, the front pad 40 has a higher amount by weight of core composite material than in other areas of the absorbent core 6 to provide the desired total absorptive capacity of at least about 32 grams.

Specification, page 23, lines 21-29. Therefore, in view of at least this disclosure, Applicants respectfully request that this objection be withdrawn.

C. Claim Rejections under 35 U.S.C. § 112, ¶ 1

Claims 1-29 stand rejected under 35 U.S.C. § 112, ¶ 1 as allegedly containing subject matter that was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Specifically, with regard to claims 1, 15, 22, 26 and 29, the Office Action asserts that “[t]he disclosure teaches a broad range of polymers and structures for the claimed invention, but fails to teach one of ordinary skill in the art the exact polymer needed or the exact method of forming the core composite material to provide the claimed test results. Without this disclosure, one of ordinary skill cannot practice the invention without undue experimentation because the number of operational parameters in the process and uncertainty as to the mechanism for forming the core material.” Applicants respectfully disagree.

As noted above, none of the polymers identified in the present application are novel, but are well-known to one of ordinary skill in the art. Further, Applicants have provided detailed description of specific polymers that may be used, at, for example, page 23, lines 21-29. Therefore, Applicants respectfully request that this rejection be withdrawn.

D. Claim Rejections under 35 U.S.C. § 102(e)

Claims 1, 3-7, 15, 17-21, 22, 24, 26 and 28 stand rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by, or in the alternative under 35 U.S.C. 103(a) as

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allegedly rendered obvious by U.S. Patent No. 4,834,735 to Alemany, *et al.* ("Alemany"). Because Alemany does not disclose each and every element of the claimed invention, or render the claims obvious, Applicants respectfully disagree.

1. Alemany does not anticipate claims 1, 3-7, 15, 17-21, 24, 26 and 28

With regard to claims 1, 3-7, 15, 17-21, 24, 26 and 28, the Office Action asserts:

Alemany discloses an absorbent core and by description, a method of designing an absorbent core comprising a composite and a wrapping material adjacent to the outer surface of the composite. The absorbent core is associated with an absorbent article, wherein the core further comprises a front pad 642 and a back pad 674 (Figures 6 and 7). It is the examiner's first position that pages 9, lines 12-24; page 10, lines 6-28; and page 21, line 25 through page 22, line 4 of the specification sets forth materials capable of providing the claimed absorptive capacity. Alemany teaches similar materials for the core (col. 7, line 58 through col. 9, line 28). Thus, Alemany inherently includes a core capable of providing the claimed absorptive capacity.

Office Action, Page 6. To better understand Applicants' positions, a brief summary of the invention will be provided below.

Applicants have unexpectedly discovered that products having a front pad absorptive capacity of at least 32 grams have low urine leakage results, regardless of the absorbent capacity of other regions of the absorbent article, and regardless of the total absorbent capacity of the absorbent article:

Protection against leakage is optimized if the front pad 40 has an average absorptive capacity of at least 32 grams as provided. Notably, the absorptive capacity of the other portions of the absorbent core 6 do not significantly affect the urine leakage results if the front pad 40 total absorptive capacity is at least about 32 grams.

Specification, page 23, lines 16-20. *See also*, Example 2 on page 32, lines 5-14 (in-vivo urine leakage test method); and Figure 6 (in-vivo urine leakage test results). This discovery has led to the ability to design more efficient absorbent cores. *See, e.g.*, Appl'n, Page 24, ll. 1-7. In following with this discovery, Applicants have further

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discovered that only a particular subset of material combinations produces an absorbent core having the claimed front pad absorbent capacity of at least 32 grams:

A number of techniques may be used to provide an optimized front pad 40 to improve leakage protection. For example, high AUL SAP may be disposed in the front pad 40 of the absorbent core 6 to provide the desired front pad total absorptive capacity of at least about 32 grams.

Alternatively, high concentrations of lower AUL SAP may be disposed in the front pad 40 of absorbent core 6 to provide the desired front pad total absorptive capacity of at least about 32 grams. In one embodiment, the front pad 40 has a higher amount by weight of core composite material than in other areas of the absorbent core 6 to provide the desired total absorptive capacity of at least about 32 grams.

Specification, page 23, lines 21-29.

Keeping this background in mind, in order for a claim to be anticipated by a reference, that reference must disclose each and every element of the claimed invention. *See Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987) ("A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference."); *see also Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989) ("The identical invention must be shown in as complete detail as is contained in the . . . claim."). To rely upon the theory of inherency, "the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990).

As admitted by the Office Action, Alemany does not expressly disclose the claimed invention. *See* Office Action, Page 6. Specifically, independent claim 1 recites that the absorbent core "comprises a front pad and a back pad, the front pad having an absorptive capacity of at least about 32 grams of an aqueous solution containing 1.0 weight % sodium chloride absorbed after ten minutes of contact with the aqueous solution while under a restraining pressure of about 0.5 psi." Appl'n, Claim 1.

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Alemany also does not inherently disclose the elements of claim 1. As discussed above, the Office Action is required to provide reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the prior art. The only reasoning provided, however, is that it discloses similar materials as the core. Applicants have shown, however, that absorbent cores having a front pad absorbent capacity greater than 32 are not inherently disclosed by the material combinations taught by Alemany. As shown in Example 1 of the present application, Applicants tested the front pad absorptive capacity for several commercially-available and experimental products. While each of the tested products has an absorbent core comprising a mixture of fluff pulp and SAP, only 2 products — Applicants' own experimental products G and M — exhibit a front pad absorptive capacity of at least 32 grams. Therefore, contrary to the Office Action's assertion, not all absorbent cores comprising fluff pulp and SAP are necessarily capable of exhibiting a front pad absorptive capacity of at least about 32 grams.

Applicants also disagree with the Office Action's characterization of claims 1, 3-7, 15, 17-21 and 26 as "product-by-process claims." There is no process by which the claimed absorbent core is produced recited in any of these claims. The phrase "wherein the absorbent core comprises a front pad and a back pad, the front pad having an absorptive capacity of at least about 32 grams of an aqueous solution containing 1.0 weight % sodium chloride absorbed after ten minutes" does not recite a process of making the product, *i.e.*, the absorbent core, but instead claims the characteristic of the product. Therefore, the Office Action's reasoning and citation of *In re Thorpe* is misplaced.¹

In sum, independent claims 1, 15, 22, 24 and 26 recite an absorbent core having a front pad is a two inch diameter circle having substantially as its center the insult point of the absorbent core, where the absorptive capacity of the front pad is at least about 32

¹ *In re Thorpe*, 777 F.2d 695 (Fed. Cir. 198)

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grams. Alemany does not disclose an absorbent core or an absorbent article having a front pad absorbent capacity greater than 32 grams, nor is this feature inherent in the disclosure of Alemany. Likewise, Alemany does not expressly or inherently disclose a method of making an absorbent article, a method of providing leakage protection in an absorbent article, or a method of designing an absorbent core, where the method involves preparing an absorbent core having a front pad absorbent capacity greater than 32 grams, as recited in claims 22, 24, 26, 28 and 29. Thus, Applicants respectfully request that the rejection of claims 1, 15, 22, 24 26 and 28-29, and the claims dependent thereon, be withdrawn.

2. Claims 1, 3-7, 15, 17-21, 24, 26 and 28 are not rendered obvious by Alemany

In the alternative, claims 1, 3-7, 15, 17-21, 24, 26 and 28 stand rejected under 35 U.S.C. § 103(a) as allegedly rendered obvious by the Office Action by Alemany. Applicants respectfully disagree, as the Office Action has failed to establish a *prima facie* case of obviousness.

In order to establish a *prima facie* case of obviousness, at least three criteria must be met. First, there must be some motivation or suggestion to make the proposed combination or modification of the references. Notably, "the teaching or suggestion to make the claimed combination must be found in the prior art, and not based on the applicant's disclosure." MPEP 2142, discussing *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. Finally, the combined or modified references must teach or suggest all claim limitations. See MPEP § 2142 *et seq.*

The Office Action has not identified any motivation in the prior art to modify Alemany. In fact, Alemany actually teaches away from the claimed invention. Specifically, Alemany only discusses that the "total absorbent capacity of the absorbent member 42 should . . . be compatible with the design liquid loading for the intended use of the absorbent article or diaper." Alemany, col. 7, lines 61-64 (emphasis added). Alemany further teaches that the hydrophilic fibers and superabsorbent material may

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be selectively deposited only in the deposition region of the absorbent article (see Alemany, col. 11, lines 42-44), and to maintain a certain minimal absorbency level in the front section of the core, the surface area of the acquisition zone should be minimized (see Alemany, col. 17, lines 13-15). One of ordinary skill in the art would not find motivation in Alemany to modify the absorbent core to achieve the claimed invention.

Even if the front pad absorbent capacity property were suggested by Alemany, there is no motivation to modify the article of Alemany to have the front pad absorbent capacity of the present invention, because to do so would render the Alemany device unsatisfactory for its intended use. Alemany teaches that product performance is improved when the acquisition zone contains less absorbent material, that is, when the acquisition zone has a lower absorbent capacity. As such, increasing the absorbent capacity at the insult point of Alemany device would directly contradict the Alemany device's theory of operation, and presumably render it unsatisfactory for its intended use. Therefore, Applicants respectfully submit that there is no motivation to modify the absorbent article of Alemany to have the claimed front pad absorbent capacity. See *In re Gordon*, 733 F.2d 900, 222 USPQ 1125 (Fed. Cir. 1984).

Because the Office Action has not established a *prima facie* case of obviousness, Applicants respectfully request that the rejection of these claims be withdrawn.

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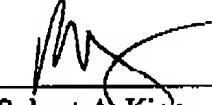
V. CONCLUSION

Applicant respectfully submits that the application is in condition for allowance. Applicant believes that no fees are necessary in connection with the filing of this document. In the event any fees are necessary, please charge such fees, including fees for any extensions of time, to the undersigned's Deposit Account No. 50-0206. Should any outstanding issues remain, the Examiner is invited to telephone the undersigned at the number listed below.

Respectfully submitted,
HUNTON & WILLIAMS LLP

Dated: August 18, 2005

By: _____


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